

REMARKS

This paper is a response to the Final Office Action that was mailed on June 19, 2009. As this paper is prior to the three-month statutory period, no fee is believed to be due.

Prior to entry of this paper, Claims 1-15 were pending and claims 1-9 were withdrawn from consideration.

I. Amendments to the Claims

In this paper, Claim 10 has been amended to recite

A soft magnetic powder comprising a plurality of compound magnetic particles, the plurality of compound magnetic particles comprising a plurality of metal magnetic particles and electrically insulating film surrounding surfaces of said metal magnetic particles;

...

This amendment is fully supported throughout the Specification, as described below. No new subject matter has been introduced by this amendment.

II. Rejections under 35 U.S.C. 112, first paragraph

In the Office Action, claims 10-12, 14, and 15 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. In particular, the Office Action asserts on page 3 of the Office Action:

That is, each of the claimed "soft magnetic powder" particles is made up of the "a plurality of compound magnetic particles" and each of these "plurality of compound magnetic particles" is made up of "a plurality of metal particles". There is no support in the application as filed for such an embodiment, therefore claims 10 to 12, 14 and 15 are directed to new matter.

The Office Action further points out that the portions of the Specification identified by Applicants as providing support, paragraphs [0027] and [0028], do not support the claimed limitations of Claim 10. Applicants respectfully disagree. Applicants further point out that the interpretation given above is erroneous and is moot in view of the language in Claim 10. Claim 10 states in part:

A soft magnetic powder *comprising* a plurality of compound magnetic particles, the plurality of compound magnetic particles comprising a plurality of metal magnetic particles and electrically insulating film surrounding surfaces of said metal magnetic particles;

(Emphasis added). That is, the soft magnetic powder comprises (1) a plurality of compound magnetic particles; and (2) the plurality of compound magnetic particles comprise a plurality of metal magnetic particles and electrically insulating film surrounding the surfaces of the metal magnetic particles.

Applicants respectfully point out that MPEP 2111.03 explicitly states: "The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps." Accordingly, support for (1) need only describe a soft magnetic powder that includes, as one of its elements, a plurality of compound magnetic particles.

Support for such an embodiment is found throughout the Clean Copy of the Substitute Specification filed on April 7, 2006 (“Specification”). For example, paragraph [0038] Specification states: “...a mixed *powder* is obtained by mixing *the compound magnetic particles 30* and the organic matter 40.” (Emphasis added). This is also supported in paragraphs [0027] and [0028] of the Specification, as previously asserted by Applicants, in combination with paragraph [0041] of the Specification (describing compacting the mixed powder to provide the shaped body).

Support for (2) does not appear to be controverted in the Office Action. In any event, support for (2) is also found throughout the Specification. (See, e.g., paragraphs [0027], [0028], and [0034] of the Clean Copy of Substitute Specification.) In view of the foregoing, Applicants respectfully submit that support claims 10-12, 14, and 15, as amended, is found throughout the Specification and respectfully request withdrawal of the rejection asserted in view of the written description requirement.

II. Rejections under 35 U.S.C. 112, second paragraph

In the Office Action, claims 10-12, 14, and 15 were also rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of Applicants’ invention. In particular, the Office Action asserts that it is unclear whether the “powder” refers to a collection of compound magnetic particles or a collection of metal magnetic particles. Applicants respectfully disagree. In view of the claim language of claim 10, as amended, Applicants submit that this issue is moot. As described above, the soft magnetic powder of claim 1 comprises a plurality of compound

magnetic particles. The plurality of compound magnetic particles, in turn, comprise a plurality of metal magnetic particles and electrically insulating film surrounding the surfaces of the metal magnetic particles. In view of the foregoing, Applicants respectfully submit that claims 10-12, 14, and 15, as amended, are not indefinite and respectfully request withdrawal of the rejection asserted under 35 U.S.C. 112, second paragraph.

CONCLUSION

It is respectfully submitted that each of the presently pending claims is in condition for allowance and notification to that effect is requested. Examiner is invited to contact the Applicants' representative at the below-listed telephone number if it is believed that the prosecution of this application may be assisted thereby. Although only certain arguments regarding patentability are set forth herein, there may be other arguments and reasons why the claimed invention is patentable. Applicants reserve the right to raise these arguments in the future.

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Respectfully submitted,

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